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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,829	01/12/2001	Stuart Berkowitz	668437600002	1904
24739 7590 05/22/2008 CENTRAL COAST PATENT AGENCY, INC 3 HANGAR WAY SUITE D WATSONVILLE, CA 95076				
EXAMINER RETTA, YEHDEGA				
ART UNIT 3622		PAPER NUMBER		
MAIL DATE 05/22/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/759,829

Applicant(s)

BERKOWITZ ET AL.

Examiner

Yehdega Retta

Art Unit

3622

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-36, 38-47 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-36, 38-47 and 49-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This office action is responsive to amendment filed February 27, 2008. Applicant amended claims 31, 42 and canceled 37 and 48. Claims 31-36, 38-47 and 49-52 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering (US 6,820,277) further in view of Saylor et al. (US 6,707,889)

Regarding claims 31 and 42, Eldering teaches receiving advertisements from participating advertisers at an advertisement managing server, and storing the advertisements associated with the advertisers in a data repository (col. 11 lines 20-47); receiving bid data over the network from participating advertisers for playing of one or more of the audio advertisements; determining whether the bid data is satisfactory to one or more of the participating services (col. 8 line 63 to col. 9 line 10); and upon the bid data being determined satisfactory, associating the bid data and identity of the accepting services with the appropriate advertisements in the data repository (see col. 9 lines 4-11); accessing rules for associating data about the user (profile) the service provider, the available advertisement and the received bids to maximize profile to the operator (see col. 2 lines 30-57, col. 7 lines 30-46, col. 8 lines 7-43). Eldering does not teach upon receiving notice of a call to one of the accepting telephone services, retrieving an appropriate ad accepted by that telephone service, and providing the

retrieved advertisement to the telephone service to be played as audio to the caller, it is taught in Saylor. Saylor teaches generating revenue by charging advertisers for including their advertisement content with the Vpage and so users may access the system for free of charge. Saylor teaches the charge may be a flat fee for a period of time, a fee for each user for whom the VAd is played or otherwise (see col. 7 lines 8-51). Saylor also teaches tracking the “hit” frequency, revenue generated, demographics, advertisement presented, transactions performed and other information so the voice content provider may be better able to target his advertising (see col. 20 lines 21-33, col. 27 lines 37-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow the advertisers of Saylor to bid for the placement of advertisement, as in Eldering so the advertisers of Saylor can bid for the highest price they are willing to pay for the ad placement and the service provide can select the advertiser with the highest bidder.

Regarding claims 32 and 43, Eldering teaches determining that the bid data is not satisfactory to any one of the participating services, notifying the participating advertiser of the determination, receiving second bid data from the participating advertiser over the network, determining whether the second bid data is satisfactory, and repeating the determining cycle until the bid data is satisfactory, or until the advertiser stops bidding (see col. 8 line 63 to col. 9 line 8).

Regarding claims 33, 34, 44 and 45, Eldering teaches wherein the bid data includes a financial arrangement regarding payment for playing the audio advertisement, wherein the financial arrangement includes revenue sharing (see Eldering abstract, col. 2 lines 50-57).

Regarding claims 35-36 and 46 and 47, Eldering teaches wherein advertisements retrieved from the data repository are selected according to a user profile of a caller to which the advertisement may be played or displayed and according to balanced ad usage rules (see col. 2 lines 25-39, col. 5 lines 30-46, col. 6 lines 1-13, col. 8 lines 23-43, col. 11 line 39 to col. 12 line 10).

Regarding claims 38, 39, 49 and 50 Saylor teaches wherein one or more of the stored advertisements are audio files; wherein one or more of the stored advertisements are Voice XML files to be inserted into voice applications to be executed by one of the telephone services (see col. 7 line 35 to col. 8 line 40). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide voice or voice xml as in Saylor in the intended purpose of providing an audio advertisement in telephone system.

Regarding claims 40, 41, 51 and 52, Eldering teaches location identifiers to locate an audio file on a server in the network are stored in a data repository and the identifiers are used to retrieve the audio file storing a plurality of audio advertisements in a database; usage data is for their use in formulation of bid data (see col. 7 line 35, col. 8 line 54).

Response to Arguments

Applicant's arguments filed February 27, 2008 have been fully considered but they are not persuasive.

Applicant argues that Eldering fairly teaches an advertising system for video ads on cable TV that includes an auction mechanism for specified ad slots with desired demographic targeted to viewers. Examiner agrees with Applicant that Eldering's invention is directed to cable TV

however Examiner would like to point out that Eldering was relayed upon for the teaching of providing for advertisers to bid for advertisement spots according to the subscriber's demographics, and one ordinary skill in the art would use Eldering's advertisement bidding system to allow advertiser to bid for any kind of advertisement spots or opportunities. Applicant also asserts that Saylor teaches a system of VBooks consisting of Vpages wherein one means of generating revenue of Vpages is to show ads to users who access the Vpages. Examiner would like to point out to Applicant that Applicant's invention is directed to providing service to callers. According to Applicant's disclosure a customer may use a telephone to have a service performed for the customer and according to the applicant the service may accessing a restaurant-locating application to locate a restaurant or to locate a phone number of another individual. According to applicant when the user makes a call to get a service an audio ad is inserts into the VoiceXML application. Saylor also teaches a customer making a call to receive service which in this case is to access a page (Vpages stored as SML based format, such as VoiceXML) and to enable the user to hear the content of the page. Saylor also teaches the service provider (VNAP) charging advertisers for including advertisement content with VPages to generate revenue. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to use Eldering's advertisement bidding system in Saylor's voice network access provider in order to optimize earning by charging the advertiser the highest bidding price rather than a fixed price.

Applicant regarding claims 35-37 and 46-48 argues that there is no teaching of balanced ad usage or using rules to maximize profit in ad selection.

Applicant discloses as follows:

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The advertising selection/retrieval server 48 selects an audio ad based upon certain predetermined rules. *The ad selection rules include: balanced ad usage rules, profit rules (e.g., revenue sharing rules), target customer profile rules, and other selection rules that will be apparent to one skilled in the art. The balanced ad usage rules ensure that audio ads are played at least a certain amount of times. The profit rules optimize the amount of earnings the operators of the present invention acquire for the playing of the audio ads.* For example, the profit rules may indicate that a first audio ad be played more often than a second audio ad when the first audio ad's financial arrangement is based upon a profit-sharing arrangement, and the second audio ad's financial arrangement is a set fee arrangement. The target customer profile rules ensure that audio ads that fit a customer profile are played. For example, a jewelry-related audio ad is played for a customer who has requested jewelry-related information. Examples of other selection rules include accounting information (such as whether the advertiser is current in its payments to the operators), application service provider configuration, and content provider configuration. (see [0026])

Eldering also teaches that one of the key function of the AMS (Ad Management System) is its ability to allow ads to be matched to groups of subscribers or to individual subscribers and economic efficiencies are created and may be used to provide revenues stream to the cable operator, profiler and ad service operator (revenue sharing). Eldering also teaches that sale/auctioning module also calculates the placement of the advertisement based on the degree of correlation and a pricing scheme ... the revenues may be optimized by announcing avails to more than one advertiser or by auctioning available avails to various advertisers or ad sources. Therefore, Eldering clearly teaches using rules to maximize the profit by taking under consideration the available advertisement, the bidding price and the demographic of the subscribers. Eldering also teach that the ad is displayed at least once and for specific period (usage rules)(see col. 5 lines 30-45).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/

Primary Examiner, Art Unit 3622